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EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 08/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/753,869**

Applicant(s)  
**GRIFFEY ET AL.**

Examiner  
**Michael Borin**

Art Unit  
**1631**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 20, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) 1-11 and 14-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status of Claims***

1. Response to restriction requirement filed 6/20/02 is acknowledged. Applicant elected, with traverse, Group II, claims 12,13. Applicant argues that there will be no significant burden of search, in part because the Groups are broadly classified in class 707, and requests rejoining Groups I and II at minimum. As was explained in the restriction requirement, the methods are patentably distinct as they have different effects and require different steps. The groups require different literature search and, for example for Groups I and II, a reference teaching identifying a compound comprising adding fragments in sequential synthesis rounds will not teach method of generating virtual library of compounds by connecting unrelated fragments. The restriction requirement is still deemed proper and is therefore made FINAL. Claims 1-11, 14-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups. Cancellation of claims 1-11, 14-26 is requested.

### ***Information Disclosure Statement***

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2. Applicants' Information Disclosure Statement filed 02/08/01 has been received and entered into the application. Accordingly, as reflected by the attached completed copies of forms PTO-1449, the cited references have been considered.

*Title, Abstract*

3. The title and abstract of the invention are not descriptive. The title and abstract do not reflect the elected invention. A new title and abstract are required which are clearly indicative of the invention to which the elected claims are directed.

***Claim Rejections - 35 USC § 112, second paragraph.***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12,13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drawn to method of identifying a compound; however, the method steps of dissecting a compound into fragments, adding fragments and tracking the addition of fragments do not result in an identifying step.

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Further, it is not whether the claims are drawn to identification of yet unknown compounds - then it is not clear how an unknown compound can be dissected into fragments, or to identification of already known compounds - then it is not clear what further identification is provided by decomposing and reconstructing a known compound.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12,13 are rejected under 35 U.S.C. 102(b) as anticipated by STN Express User Guide (version 4.0, 1996).

The instant claims 12,13 are drawn to method of identifying, *in silico*, a compound, comprising, for claim 12 steps of:

- a) dissecting a compound into fragments,
- b) adding fragments in sequential synthesis rounds,
- c) tracking the addition of the fragments.

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For claim 13, an additional step is to represent each fragment as a link between a fragment and a reagent used to introduce such fragment.

Synthesis rounds are correlated with addition of fragments (p. 17, line 29).

STN's Guide teaches methods of presenting chemical compound formulas *in silico*. The Guide teaches that a compound can be presented, first, as a set of fragments, then fragments can be placed together, and added together at variable points of attachments according to valencies of the fragments. See pages 110-115. Further, the reference teaches that the fragments can be presented as a reagent and a reactant and a link therebetween (see pages 164-179).

Under the principles of inherency, if a prior art method, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art. When the prior art method is the same as a method described in the specification, it can be assumed the method will inherently perform the claimed process. In the instant case, the referenced method comprises all method steps identified in the instant claims.

It is the Examiners position that all the elements of Applicant's invention with respect to the specified claims are instantly disclosed by the teaching of the reference cited above.

***Conclusion.***

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6. No claims are allowed

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 19, 2002

mlb

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

